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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Xuzhi Qin Examiner: Philip C. Tucker
Serial No. 10/038,350 Group Art Unit: 1712
Filed: November 20, 2001 Docket No. 589.117US1
Title: PHOTOCHROMIC NAPHTHOPYRAN COMPOUNDS: COMPOSITIONS AND
ARTICLES CONTAINING THOSE NAPHTHOPYRAN COMPOUNDS

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED
APPLICATION UNDER 37 CFR 1.137(b)**

Dear Sir/Madam:

FACTUAL BACKGROUND

- 1) An Office Action for the above-identified patent application was mailed by the U.S. Patent and Trademark Office on January 29, 2002, with a due date for a response identified on the Office Action as 1 month from the mailing date, or February 28, 2002 (copy enclosed).
- 2) On October 2, 2002, Examiner Lilling called Mark A. Litman & Associates, P.A. to inquire as to a lack of response to the Office Action, and to notify that failure to respond will result in abandonment of the case.
- 3) Upon investigation, it was discovered that the docket date was listed correctly in the attorney's docketing calendar but it was unintentionally removed without work being done on the case.
- 4) As the documents included with this Petition clearly shows that all formalities for this Application were timely performed by Attorney for Applicants and timely received by the U.S. Patent and Trademark Office, the Abandonment of this Application is clearly in error, was inadvertent and/or unintentional, and should be accepted at this time.

5) Applicants, through their counsel, petitioned to have the abandoned application revived under 37 CFR 1.137(b) in a Petition filed 27 September 2004, but that Petition was refused in a Notice mailed 10 November 2004, which allowed further response to 10 January 2005. The Petition was dismissed because an amendment had not been filed that that automatically placed the application in condition for allowance, a Notice of Appeal had not been filed and/or a request for consideration under the Rules had not been filed.

6) The present Petition files an Amendment that is accompanied by an Amendment that clearly places the Application in condition for allowance, a Petition for Extension of time, insofar as that is needed, and **alternatively**, a request for Continued Examination. Petition to

7) Applicants, through their Attorney of Record, hereby petition to have the Application re-opened, and to have the Abandonment withdrawn.

8) The fee required for a petition to revive an unintentionally abandoned application under 1.17(m), the amount set forth of \$1,330.00, is hereby authorized to be withdrawn from Attorney's Deposit Account No. 50-1391, as is any fee for any Extension of Time or the Request for Continued Examination..

The other required reply in this Application under the guidelines of 37 C.F.R. 1.37(b) constituted only the cancellation of the two rejected claims, which is respectfully submitted at this time. Nothing further was requested and each of the required steps prior to the Office Action was timely done as shown by the enclosed documents. As the Response to the Restriction Requirement has now been submitted, the Application should be re-opened.

Applicants hereby petition to revive the application due to the fact that the delay in filing the response to the Office Action causing by the abandonment of the application was unintentional and/or inadvertent, and was the sole responsibility of the U.S. Patent and Trademark Office.

The contact person is invited to telephone Applicant's attorney (952) 832-9090 if necessary. **If necessary please charge any additional fees to Deposit Account No. 50-1391 for the petition for revive unintentional abandonment under 37 CFR 1.137(b).**

Respectfully submitted,

Xuzhi Qin

By His Representatives,

Mark A. Litman & Associates, P.A.
York Business Center, Suite 205
3209 West 76th Street
Edina, MN 55435
(952) 832-9090

Date: 28 December 2004

By

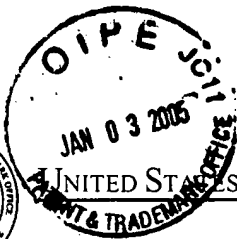


Mark A. Litman
Reg. No. 26,390
(952) 932-9090

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on 28 December 2004.

Mark A. Litman
Name


Signature



UNITED STATES PATENT AND TRADEMARK OFFICE

man
FINAL OFFICE ACTIONUNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,350	11/20/2001	Xuzhi Qin	589.117US1	7050

7590 01/15/2004

Mark A. Litman & Associates, P.A.
York Business Center, Suite 205
3209 West 76th St.
Edina, MN 55435

EXAMINER

TUCKER, PHILIP C

ART UNIT PAPER NUMBER

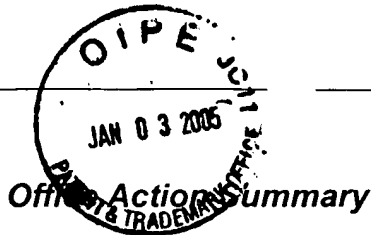
1712

DATE MAILED: 01/15/2004

Due April 15 2004 ✓
D

Please find below and/or attached an Office communication concerning this application or proceeding.

received
1:20:04 AM



Application No.

10/038,350

Applicant(s)

QIN, XUZH

Examiner

Philip C Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 9-11 and 13-19 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 12 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 12 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claim 12, when m is 2, this falls outside of the scope of the invention claimed in the parent claim 1.
2. Claim 12 is objected to because of the following informalities: In claim 12, the line after the formulae states "(1a), (1b), and (1c) below", whereas the formulae appear above this line. Applicant should delete the word "below" and insert "above", or move the formulae below said line in order to correct the claim. Appropriate correction is required.
3. Claims 1-4, 9-11 and 13-19 are allowable over the art of record.
4. Applicant's amendment has overcome the prior art rejections of the previous office action. Applicant has not addressed the objection to the relative position of the formulae and line below such formulae in claim 12. A new objection is presented in view of applicant's amendment.

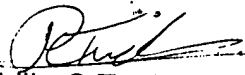
Application/Control Number: 10/038,350
Art Unit: 1712

Page 3

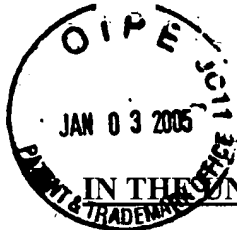
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2936



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Xuzhi Qin Examiner: Philip C. Tucker
Serial No. 10/038,350 Group Art Unit: 1712
Filed: November 20, 2001 Docket No. 589.117US1
Title: PHOTOCROMIC NAPHTHOPYRAN COMPOUNDS: COMPOSITIONS AND
ARTICLES CONTAINING THOSE NAPHTHOPYRAN COMPOUNDS

MAIL STOP RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

***ALTERNATIVE REQUEST FOR RCE IN COMBINATION WITH A PETITION TO
REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR
1.137(b)***

This is an **ALTERNATIVE** request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

1. **Submission required under 37 CFR 1.114**

- a. ☐ Previously submitted
i. ☐ Consider the amendment(s)/reply under 37 CFR 1.116 previously filed on
ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
iii. ☐ Other
b. ☒ Enclosed
i. ☒ Amendment/ Reply iii. ☐ Information Disclosure Statement (IDS)
ii. ☐ Affidavit(s)/Declaration(s) iv. ☐ Other, Preliminary Amendment (12 pages)

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months
b. ☐ Terminal Disclaimer (2 pages)

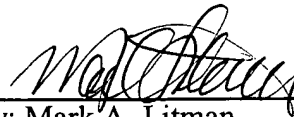
3. **Fees**

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account Number 50-1391, **ONLY IF THE PTO DECIDES IN THE ACCOMPANYING PETITION FOR REVIVAL OF THE UNINTENTIONALLY ABANDONED APPLICATION THAT THE AMENDMENT DOES NOT PRIMA FACIE PLACE THE APPLICATION IN CONDITION FOR ALLOWANCE.**
i. ☒ RCE Fee required under 37 CFR 1.17(e), the amount of \$ 790.00.
ii. ☒ Extension of Time fee, the amount UP TP \$ 1020.00.
iii. ☐ Other
☒ Transmittal Sheet ☐ Petition under 37 CFR 1.137(b)
☒ Return postcard ☐ AMENDMENT UNDER 37 CFR.1.116 (9 PAGES +3 PAGES ATTACHMENT, Office Action)

01/04/2005 HAL111 00000032 501391 10038350

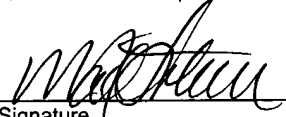
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MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205, 3209 W. 76th St.
Edina, MN 55435 (952-832-9090)

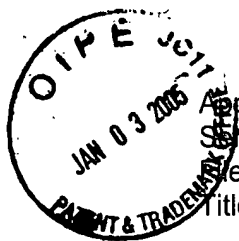
By: 
Atty: Mark A. Litman
Reg. No. 26,390

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop: PETITION and RCE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on July 12, 2004.

Mark A. Litman
Name


Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: Xuzhi Qin
 Serial No. 10/038,350
 Filed: November 20, 2001
 Title: PHOTOCHROMIC NAPHTHOPYRAN COMPOUNDS: COMPOSITIONS AND ARTICLES CONTAINING THOSE NAPHTHOPYRAN COMPOUNDS

Examiner: Philip C. Tucker
 Group Art Unit: 1712
 Docket No. 589.117US1

MAIL STOP: PETITION and AF

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

The following documents are hereby submitted:

- ☒ 3rd Supplemental Amendment and Response After Final Rejection (9 pages)
- ☒ Transmittal Sheet ☒ Alternative Request for RCE (2 Pages)
- ☒ Petition to Revive Under 37 CFR 1.137(b) (3 Pages)
- ☒ Petition for Extension of Time (as needed)
- ☒ Return Postcard

If an additional fee is required due to changes to the claims, the fee has been calculated as follows:

CLAIMS AS AMENDED						
	(1) Claims Remaining After Amendment		(2) Highest Number of Claims Previously Paid For	(3) Present Extra	Rate	Fee
TOTAL CLAIMS	16	-	20	0	x 18.00 =	\$00.00
INDEPENDENT CLAIMS	1	-	3	0	X 86.00 =	\$00.00
[] MULTIPLE DEPENDENT CLAIMS PRESENTED						\$00.00
TOTAL						\$00.00

Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP: AF, P.O. BOX 1450, Commissioner for Patents, Alexandria, VA 22313-1450 28 DECEMBER 2004

Mark A. Litman
 Name

Signature

MARK A. LITMAN & ASSOCIATES, P.A.
 York Business Center, Suite 205, 3209 W. 76th St.
 Edina, MN 55435 (952-832-9090)

By:
 Atty: Mark A. Litman
 Reg. No. 26,390